

REMARKS

Claim 1 has been canceled, and Claims 28 and 31-33 have been amended. Claims 28-35 are pending in the application. In view of the foregoing amendments, and the remarks that follow, Applicants respectfully request reconsideration.

Amendments to the Claims

Applicants noted a minor and inadvertent error in independent Claim 28, in that the first reference to “said storage node shape” should instead be a reference to “said conductive via structure”. Both the error and the appropriate correction would be immediately evident to any person of ordinary skill in the art who was reading Claim 28 with reference to the embodiment shown in the drawings. The foregoing amendments to Claim 28 correct this obvious error, and also make some improvements with respect to grammar and antecedent relationships. The amendments to dependent Claims 31-33 implement improvements with respect to antecedent relationships. The amendments to Claims 28 and 31-33 do not change the intended scope of any pending claim.

First Paragraph of 35 U.S.C. §112

The Office Action rejects Claims 28-35 under the first paragraph of 35 U.S.C. §112, asserting that a particular passage in independent Claim 28 does not appear to have any corresponding description in the specification, and that the application therefore fails to comply with the written description requirement. This ground of rejection is respectfully traversed, for the following reasons.

The §112 rejection is not complete, because it fails to meet certain specific requirements set forth in the MPEP. In more detail, MPEP §2163.04 is entitled “Burden on the Examiner with Regard to the Written Description Requirement”, and sub-section (I) sets forth the requirements for rejecting a claim for failure to comply with the written description requirement, as follows:

In rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion

These findings should:

- (A) Identify the claim limitation at issue; and
- (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. . . .

When appropriate, suggest amendments to the claims which can be supported by the application's written description, being mindful of the prohibition against the addition of new matter in the claims or description.

In the present application, the §112 rejection complies with MPEP requirement (A), because it points out the claim limitation at issue, which is the following subparagraph from Claim 28 (as originally presented):

a storage node shape with a first portion of said storage node shape overlying a conductive via structure, wherein said storage node shape is located in an opening in an insulator layer, and wherein said conductive via structure contacts a source/drain region of an underlying metal oxide semiconductor field effect transistor (MOSFET), and wherein a second portion of said storage node shape overlying portions of a top surface of said insulator layer; . . .

However, the §112 rejection stops there, and does not even attempt to comply with MPEP requirement (B). In particular, the rejection makes no attempt at all to set forth “express findings of fact” that “Establish a *prima facie* case by providing reasons why a person skilled in the art” would have recognized that the inventor was not in possession of the claimed invention. In other words, the Examiner has not carried the burden that MPEP §2163.04 refers to as the “Burden on the Examiner with Regard to the Written Description Requirement”. Consequently, the §112 rejection is not complete and is therefore defective, and it is respectfully submitted that the rejection must be withdrawn.

Since the Examiner fails to provide required information such as “express findings of fact” that “Establish a *prima facie* case“, it is not at all clear to Applicants why the Examiner is making the rejection. Applicants believe that a person of ordinary skill in the art will readily recognize that the specification provides a clear written description for everything recited in the indicated portion of Claim 28. By way of example, Applicants are reproducing below the indicated portion of Claim 28 (as amended herein), with the addition of square brackets containing reference numerals and other information to indicate where the originally-filed drawings and specification provide a written description of this subject matter:

a storage node shape [23, 13, 14, 16] with a first portion of said storage node shape [the portion above via plugs 10 and 12] overlying a conductive via structure [10, 12], wherein said conductive via structure [10, 12] is located in an opening [21, 22] in an insulator layer [8, 11], and wherein said conductive via structure [10, 12] contacts a source/drain region [7] of an underlying metal oxide semiconductor field effect transistor (MOSFET) [2, 3, 4, 6, 7], and wherein a second portion of said storage node shape [the portion other than the first portion] overlies portions of a top surface of said insulator layer [top surface of 11]; . . .

It should be clear that everything recited in this portion of Claim 28: (1) is in fact shown in the drawings, (2) is identified with reference numerals in the drawings, and (3) is described in detail in the specification in association with the reference numerals. Applicants therefore respectfully submit that there is no reasonable basis for the assertion in the Office Action that the specification provides absolutely no written description of any of this subject matter from Claim 28. Accordingly, it is respectfully submitted that this is a further and separate reason why the §112 rejection is not proper, and must be withdrawn.

Claims 29-35 depend from Claim 28, and were rejected under §112 solely because of their dependency from Claim 28. Dependent Claims 29-35 are believed to be in compliance with §112, for example for the same reasons discussed above with respect to independent Claim 28.

Applicants wish to add that the foregoing presentation of language from Claim 28 with the addition of bracketed information is offered solely by way of example (in order to show one way that the present application provides a written description of that subject matter), and is not intended to effect or suggest any restriction or limitation whatsoever to the broad scope of Claim 28.

Allowability of the Pending Claims

Applicants note with appreciation that the Office Action does not reject any of Claims 28-35 as unpatentable over the art of record. As discussed above, Claims 28-35 are all believed to be in compliance with 35 U.S.C. §112. Therefore, Claims 28-35 are all believed to be in condition for allowance, and notice to that effect is respectfully requested.

Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way

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by a telephone conference, the Examiner is invited to telephone the undersigned attorney at 972-739-8635.

Although Applicants believe that no fee is due in association with the filing of this Response, the Commissioner is hereby authorized to charge any additional fee required by this paper, or to credit any overpayment, to Deposit Account No. 08-1394 of Haynes and Boone LLP.

Respectfully submitted,



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Enclosures: None

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